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09/753,171	12/29/2000	Victor R. Sanchez	CAS1PAU24R2	9702 2088 20
7590	07/18/2003			
Myers, Dawes & Andras 19900 MacArthur Boulevard Suite 1150 Irvine, CA 92612			EXAMINER	CORBIN, ARTHUR L
		ART UNIT	PAPER NUMBER	
		1761		

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20

Application Number: 09/753,171

Filing Date: December 29, 2000

Appellant(s): SANCHEZ ET AL.

MAILED

JUL 18 2003

GROUP 1700

Joseph C. Andras

For Appellant

**EXAMINER'S ANSWER**

This is in response to the brief on appeal filed May 6, 2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 38-57 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) ClaimsAppealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The error identified in the reissue declaration applies only to the parent reissue. A different error that applicant relies upon to support the instant continuation reissue application must be identified in a supplemental reissue declaration.

Claims 38-57 are rejected as being based upon a defective reissue declaration under 35 USC 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above [REDACTED] in this Office action.

Claims 38-57 <sup>are</sup> rejected under 35 USC 251 as lacking basis for reissue. By statute a reissue application can only be granted for the unexpired portion of the term of the original patent. Since the original patent 5,635,235 has expired due to nonpayment of maintenance fees, no reissue can be issued. A petition for retroactive payment of maintenance fees or to restore the patent term may be filed.

Claims 38-57 also stand rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two-year statutory period. The following claim limitations are broader in scope than the original patent claims: "a projection" (claims 38, 45 and 52, line 4) since original patent claim 15 recites "projections"; "the projection" (claims 38 and 45, line 8 and claim 52, lines 10-11). Additionally, the removal from claim 38 of the steps of rotating the shaft and removing gas bubbles, as recited in

Art Unit: 1761

original patent claim 15, constitutes broadening. Further, the absence from claim 45 of the steps of rotating the shaft and forcing the masa through the slot, as recited in original patent claim 15, constitutes broadening. Finally, the absence from claim 52 of the step of rotating the shaft, as recited in original patent claim 15, constitutes broadening. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

**(11) Response to Argument**

Appellant's arguments in the Appeal Brief submitted May 6, 2003 have been fully considered but they are not persuasive. Since there are other errors at issue in the instant application which were not present in the parent reissue application at least one of these other errors must be identified in the reissue declaration of the instant application. The reasons for further broadening the claims in the instant reissue application are totally unrelated to the reasons originally presented for filing the parent reissue application. Thus, in any request for reissue in which a new set of facts is relied upon in support of errors in the patent, a copy of a declaration filed in a previous reissue, i.e. parent reissue, could not possibly comply with the requirements of 37 CFR 1.175. The only error in the copy said declaration was related to the original patent, which is not the patent for which this continuation reissue is now seeking reissue. Thus it could be argued that the instant continuation reissue application was filed as a "no

defect" reissue. Further, appellant's contention that a CPA, rather than a 37 CFR 1.60 continuation, could have been filed to further prosecute the parent reissue application, is without merit. In that situation only one reissue patent would have issued to cover all errors, whereas appellant now seeks a second reissue patent to cover a second set of errors.

Appellant's attempt to justify the broadening in the instant reissue application outside of the two-year statutory period based upon In re Doll is without merit. In Doll, it was held that if a broadening reissue application was filed within the two year period permitted by 35 USC 251, then a further broadening of the claims, within that application, which occurs after the two years has expired, is permitted.

The facts at issue herein differ from Doll in that this is a continuation reissue, i.e. a separate application from the parent reissue, based upon a set of facts which are totally unrelated to the facts which caused the parent reissue to be filed. If the facts which led to the filing of the first broadened reissue (parent) had not occurred, so that there had been no need to file the first or parent reissue application, there is no question that appellant would not be able to broaden the patent claims at the date of filing of the instant reissue application. Thus, if the facts were entirely the same here except that there had been no need to file the first or parent reissue application, appellant would have no recourse at this time because the two year period for broadening patent claims has expired. Therefore, appellant is using the fortuitous and unrelated events which

Art Unit: 1761

led to the first or parent reissue as granting appellant a right it would not have had if the fortuitous and unrelated events had not occurred. A reissued patent should not confer upon the patentee a procedural right that the patentee would not have had if the original patent had been kept.

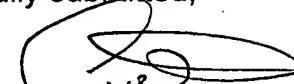
According to appellant's way of thinking, if a patentee is lucky enough to have cause to file a broadening reissue within two years of the original patent, he is essentially given a free license to broaden the claims further and in entirely different or unrelated ways during the entire term of the patent as long as the patentee maintains a perpetual and continuing chain of reissue applications. This is contrary to the strong public policy intended to be enforced by the last paragraph of 35 USC § 251.

Finally, it is worth noting that Ex parte Luu, a decision rendered by the Board of Appeals in SN 08/188,764, is quite similar to the issues on appeal herein. In that decision, the Board of Appeals affirmed the examiner's rejections under 35 USC 251 using reasoning substantially the same as that set forth above.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1761

Respectfully submitted,



ARTHUR L. CORBIN  
PRIMARY EXAMINER

7-11-03

A. Corbin  
July 10, 2003

Conferees

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner can normally be reached on Tuesday-Friday from 10 a.m. to 7:30 p.m. and on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A. Corbin/dh  
June 20, 2003